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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

APPEAL BRIEF TRANSMITTAL		Docket Number: 10191/3186	Conf. No. 5906
Application Number 10/600,894	Filing Date June 20, 2003	Examiner Thu V. Nguyen	Art Unit 3661
Invention Title DRIVER INFORMATION DEVICE		Inventor Holger LISTLE et al.	

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Jong H. Lee

Further to the Notice of Appeal dated June 29, 2006 for the above-referenced application, enclosed are three copies of an Appeal Brief. Accompanying the Appeal Brief is the Appendix to the Appeal Brief.

The Commissioner is hereby authorized to charge payment of the 37 C.F.R. § 41.20(b)(2) appeal brief filing fee of **\$500.00**, and any additional fees associated with this communication, to the deposit account of **Kenyon & Kenyon LLP**, deposit account number **11-0600**.

 (R. No.
36,197)

Dated: August 28, 2006

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Holger LISTLE et al.

Application No. : 10/600,894

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For : DRIVER INFORMATION DEVICE

Art Unit : 3661

Examiner : Thu V. NGUYEN

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APPELLANTS' APPEAL BRIEF
UNDER 37 C.F.R. § 41.37

SIR :

Applicants filed a Notice of Appeal dated June 29, 2006, appealing from the Final Office Action dated May 3, 2006, in which claims 15-18 of the above-identified application were finally rejected. This Brief is submitted by Applicants in support of their appeal.

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I. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Robert Bosch GmbH of Stuttgart, Germany. Robert Bosch GmbH is the assignee of the entire right, title, and interest in the present application.

II. RELATED APPEALS AND INTERFERENCES

No appeal or interference which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal is known to exist to the undersigned attorney or is believed by the undersigned attorney to be known to exist to Applicants.

III. STATUS OF CLAIMS

Claims 1-10 and 12-19 are pending in the present application, and claims 15-18 are being appealed. Claim 11 was canceled in the Amendment dated November 11, 2004. Among the pending claims, claims 1-10 and 12-14 have been previously withdrawn, and claim 19 has been objected to by the Examiner. Among the appealed claims, claim 15 is independent, and claims 16-18 ultimately depend on claim 15.

IV. STATUS OF AMENDMENTS

Subsequent to the final Office Action mailed on May 3, 2006, Applicants mailed on June 29, 2006 a "Rule 116 Amendment," in which Applicants presented amended claim 19 (presenting claim 19 in independent form including the limitations of parent claim 15 and the intervening claim 17). Despite the Examiner's indication in the final Office Action that claim 19 "would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims," the Examiner has refused to enter the proposed amendment to claim 19 presented in the "Rule 116 Amendment." (See Advisory Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

With respect to independent claim 15, the present invention provides a driver information device including:

a map display (Figs. 1 and 2, elements 3 and 4); (Specification, p. 3, l. 10-11);

special objects being represented on the map display by special object symbols (Figs. 1 and 2, symbols 11 and 12); (Specification, p. 3, l. 29 –p. 4, l. 3);

a common indicator symbol (Figs. 1 and 2, symbol 13) in the map display indicating a presence of corresponding multiple special objects one of (a) in one location and (b) within a preselected radius of a location; (Specification, p. 1, l. 20 – p. 2, l. 2; p. 4, l. 3-5);

a selection of the common indicator symbol enabling a display of a selection menu (Fig. 2, window 16) containing information about the corresponding multiple special objects, wherein the selection menu is displayed on the map display; (Specification, p. 4, l. 23 – p. 5, l. 7); and

during the display of the selection menu, the common indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu. (Fig. 2; Specification, p. 4, l. 28-29; p. 5, l. 3).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following ground of rejection is presented for review on appeal in this case:

(A) Whether pending claims 15-18 are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2002/0130906 ("Miyaki") in view of U.S. Patent Application Publication No. 2003/0085910 ("Noble"), U.S. Patent No. 6,640,185 ("Yokota") and U.S. Patent Application Publication No. 2002/0145632 ("Shmueli").

VII. ARGUMENTS

A. Rejection of Claims 15-18 Under 35 U.S.C. § 103(a)

Claims 15-18 are rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0130906 ("Miyaki") in view of U.S. Patent Application Publication No. 2003/0085910 ("Noble"), U.S. Patent No. 6,640,185 ("Yokota") and U.S. Patent Application Publication No. 2002/0145632 ("Shmueli"). Applicants respectfully submit that the combination of Miyaki, Noble, Yokota and Shmueli does not render obvious the subject matter of claims 15-18, for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). To the extent the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Independent claim 15 recites, in relevant parts, "a map display, special objects being represented on the map display by **special object symbols**, a **common indicator symbol** in the map display **indicating a**

presence of corresponding multiple special objects one of (a) in one location and (b) within a preselected radius of a location, **a selection of the common indicator symbol enabling a display of a selection menu containing information about the corresponding multiple special objects**, wherein the selection menu is displayed on the map display; wherein during the display of the selection menu, **the common indicator symbol is displayable at a same location on the map** where it was displayed before the display of the selection menu, **embedded in the selection menu.”**

In support of the obviousness rejection, the Examiner asserts the following arguments for combining the selected teachings of the applied references: a) “Miyaki teaches superimposing a menu on the map (paragraph 0045); b) “Noble teaches displaying the indicator symbol 102, and 106 (Fig. 2) at the same location on the map (Fig. 2); c) Yokota suggests displaying a selectable menu 120-122 (Fig. 12B); and d) “Shmueli teaches displaying a selection menu 88-92 (Fig. 6) with a symbol 86 (Fig. 6) displayable at the same location on the display and embedded in the selection menu (Fig. 6).” Based on these assertions, the Examiner summarily concludes that “[i]t would have been obvious . . . to display the menu taught by Miyaki as selectable menu as taught by Yokota and to display the menu embedding the symbol at the same location on the map as taught by the combined teachings of Noble and Shmueli in order to allow the user to obtain more information on an interested point of interest at the area the point of interest is located.” Applicants will address the Examiner’s assertions in detail below.

Applicants initially note that the Examiner’s stated rationale for making the asserted combination of the specific teachings of the applied references is clearly inadequate to support the asserted combination. The only stated rationale supporting the Examiner’s asserted combination is that the combination would “allow the user to obtain more information on an interested point of interest at the area the point of interest is located.” However, even if one assumes that a person of ordinary skill in the art would be motivated by the goal of “allowing the user to obtain more information on an interested point of

interest at the area the point of interest is located,” with which assumption Applicants do not agree, it is simply unreasonable to suggest that one of ordinary skill in the art, without knowing anything about Applicants’ claimed invention, would actually be motivated to specifically pick out the selected parts of each of the applied references and combine the selected parts in the exact manner asserted by the Examiner. In fact, the Examiner does not even state why one of ordinary skill in the art would initially arrive at the “combined teaching of Noble and Shmueli,” which is further combined with other specific teachings of Miyaki and Yokota.

Applicants note that the Examiner’s obviousness rationale is a classic example of an “obvious-to-try” rationale, which is insufficient to support a *prima facie* obviousness: the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). With respect to the subjective “obvious to try” standard, the cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), clearly indicate that the Examiner’s generalized assertions that it would have been obvious to combine or modify the references relied upon do not properly support an obviousness rejection. In particular, the Court in the case of In re Fine stated: “Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to **pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**” In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if it be called evidence) that one of ordinary

skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention]. In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted).

Applicants note that the Examiner has offered no evidence whatsoever of actual suggestion in the applied prior art to make the asserted modification, but only conclusory hindsight, reconstruction and speculation, which the Court of Appeals for the Federal Circuit has indicated does not constitute evidence that will support a proper obviousness finding. In fact, Applicants will address the overall teachings of the applied references in detail below, and demonstrate that the overall teachings actually negate the Examiner's obviousness conclusion. (See MPEP 2141.02 VI, noting that "prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention"; see also MPEP 2143.01 V & VI, noting that obviousness is negated if the proposed modification renders the prior art being modified unsatisfactory for its original intended purpose or changes the principle of operation of the prior art being modified).

With respect to the teachings of Miyaki, Applicants note that Miyaki actually teaches away from the overall combination asserted by the Examiner, i.e., Miyaki teaches away from showing the common indicator symbol at the same place in the map and embedded in the selection menu. Miyaki shows two different specific embodiments: in the first specific embodiment (paragraph 0045), upon a selection of the multiple-icon icon 51, this icon is substituted by the individual POI icons, i.e., in this specific embodiment no menu is displayed at all; in the second specific embodiment, only a list of POI's having assigned supplementary data is displayed, i.e., no multiple-icon icon is displayed. Therefore, by teaching that **one should fade out the multiple-icons during an operator selection**, Miyaki clearly teaches away from creating a spatial relationship between any sort of a displayed list and a simultaneously displayed common indicator symbol for multiple places of interest on the map, i.e., the overall teachings of Miyaki clearly negate the idea that one of ordinary skill in the art would actually incorporate selective teachings of Miyaki to arrive at an

arrangement in which “during the display of the selection menu, the common indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu.”

In the “Response to Arguments” section of the final Office Action, the Examiner contends that since “Miyaki teaches the capability to display the common indicator object 51 (Fig. 8), displaying the common indicator object together with the multiple special objects would have been a mere matter of design choice.” (Final Office Action, p. 5). Applicants respectfully note that the Examiner’s “design choice” argument is nothing more than a self-serving conclusion that is not supported by any objective evidence. In any case, the Examiner’s “design choice” argument completely ignores the plain text of the Miyaki: Miyaki clearly indicates that **one should fade out the multiple-icons during an operator selection**, and there is no logical reason why one of ordinary skill in the art would selectively ignore this teaching of Miyaki, let alone the fact that, as a matter of law, the Examiner cannot ignore this teaching. (See, e.g., MPEP 2141.02 VI, noting that “prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention”).

Yokota also teaches away from the Examiner’s asserted combination in an even more fundamental way: In Yokota, a selection menu is only shown instead of a map. Accordingly, the idea that one of ordinary skill in the art would actually incorporate the teachings of Yokota selectively to arrive at an arrangement in which “**during the display of the selection menu, the common indicator symbol is displayable at a same location on the map** where it was displayed before the display of the selection menu, **embedded in the selection menu,**” is completely negated by the overall teachings of Yokota.

In the “Response to Arguments” section of the final Office Action, the Examiner contends that “Yokota teaches the capability of displaying a map (Fig. 12B) and a menu 120 (Fig. 12B), incorporating the display of the two figures (the menu and a map) would have been an obvious matter of design

choice,” and that “[t]his obviousness is also disclosed by the applicant in page 5, lines 12-14.” The Examiner’s “design choice” argument is once again a self-serving conclusion that is not supported by any objective evidence. In addition, the Examiner’s “design choice” argument completely ignores the plain text of Yokota, which indicates that a selection **menu is only shown instead of a map**. To the extent the Examiner references the disclosure contained in the Applicants’ specification in support of the obviousness, Applicants note that the teaching or suggestion to make the claimed combination must be found in the prior art and **not based on the application disclosure**. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

With respect to the teachings of Noble and Shmueli, the Examiner implicitly assumes that one of ordinary skill in the art would selectively combine the teachings of Noble and Shmueli to arrive at “the menu embedding the symbol at the same location on the map.” Although there is no apparent reason why anyone would make this selective combination, even if one assumed that there was some motivation to combine the teachings of Noble and Shmueli, the asserted combination would not result in the combined teaching alleged by the Examiner, let alone provide a component teaching for a rationale combination to arrive at the claimed invention. While the Examiner contends that Noble teaches displaying the indicator symbol 102 and 106 at the same location on the map, the specification of Noble clearly indicates that 102 and 106 are not common-indicator icons; instead, Paragraph [0042] of Noble clearly indicates that 102 represents “cluttered symbols,” and 106 is merely an expanded display of the cluttered symbols 102. Accordingly, 102 and 106 of Noble have nothing to do with the feature that “during the display of the selection menu, the common indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu.” In addition, while Shmueli discloses a selection menu in which a selection field “launch button” can be expanded by additional selection fields, there is simply no suggestion of **applying this expansion to a map display**, let alone any suggestion of displaying a common indicator symbol that continues to be represented in a map display. Accordingly, there is simply no

support for the Examiner's assertion that the combined teachings of Noble and Shmueli would result in display of a selection menu embedding the common indicator symbol at the same location on the map where it was displayed before the display of the selection menu."

In the "Response to Arguments" section of the final Office Action, the Examiner contends that "moving the menu taught by Noble to overlap the map at the location where the common indicator symbol is would have been obvious matter of design choice, [since] this menu presentation format with graphical user interface features has been suggested by Shmueli in Fig. 6." (Final Office Action, p. 6). Not only is the Examiner's "design choice" argument completely unsupported by any objective evidence, but the assertion that the claimed menu presentation format has been suggested by Shmueli in Fig. 6 is completely false: Shmueli merely discloses a selection menu in which a selection field "launch button" can be expanded by additional selection fields, but there is simply no suggestion of applying this expansion **to a map display**, let alone any suggestion of displaying a **common indicator symbol that continues to be represented in a map display**.

In addition to the above, with respect to the Examiner's asserted combination of the teachings of Noble with the teachings of Miyaki, Applicants note that the logical result of the combination would not approximate the features of the present claimed invention. Noble merely suggest taking symbols, which overlap in a crowded section of a map, and displaying the symbols once more in a list. If one were to incorporate this teaching of Noble into the system of Miyaki, the result would be, at best, the following: After the multiple-icon symbol of Miyaki is resolved into individual component icons, in addition to displaying the individual component icons overlapping one another, an additional list is displayed which, however, **does not include a multiple-icon symbol**. Consequently, incorporation of the teachings of Noble into the system of Miyaki would not result in the feature of "**a selection of the common indicator symbol enabling a display of a selection menu containing information about the corresponding multiple special objects, . . . wherein**

during the display of the selection menu, the **common indicator symbol is displayable at a same location on the map** where it was displayed before the display of the selection menu, **embedded in the selection menu.”**

In addition to the above, with respect to the asserted incorporation of the teachings of Shmueli into the overall combination of teachings in an effort to approximate the present claimed invention, it should be noted that Shmueli discloses a menu structure of an operator interface but **no road map**. Accordingly, Shmueli clearly does not suggest that a multiple-icon symbol **displayed on a map** can be expanded so that a selection menu is displayed around the multiple-icon symbol still displayed at the same location on the map.

A fundamental flaw in the Examiner’s asserted obviousness analysis is that the Examiner ignores overall teachings of the applied references which negate any suggestion for making the selective combination asserted by the Examiner. While the Examiner has assembled a selective combination of elements disclosed in the applied references of Miyaki, Yokota, Noble and Shmueli, there is simply no objective suggestion to make the specific combination asserted by the Examiner, and the actual overall teachings of the applied references negate any suggestion for combining the selected teachings in the manner asserted by the Examiner. In an effort to overcome this glaring deficiency, the Examiner has resorted to repeated assertions of “obvious design choices,” but the Examiner has failed to provide any objective evidence to support the assertions “obvious design choices.”

For the foregoing reasons, the overall teachings of Miyaki, Yokota, Noble and Shmueli fails to teach or suggest the subject matter of claim 15, i.e., a common indicator symbol (corresponding to multiple special objects) shown on a map, which common indicator symbol, upon selection, is simultaneously included in a selection menu superimposed on the map and continues to be displayed at the same spot on the map even during the display of the selection

menu. Accordingly, Applicants respectfully submit that claim 15 and its dependent claims 16-18 are not rendered obvious by the applied references.

Reversal of the obviousness rejection of claims 15-18 is therefore respectfully requested.

VIII. **CONCLUSION**

For the foregoing reasons, it is respectfully submitted that the final rejection of claims 15-18 should be reversed.

Claims Appendix, Evidence Appendix and Related Proceedings Appendix sections are found in the attached pages.

Respectfully submitted,

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**APPENDIX TO APPELLANT'S APPEAL BRIEF
UNDER 37 C.F.R. § 41.37**

CLAIMS APPENDIX

The claims involved in this appeal, claims 15-18, in their current form after entry of all amendments presented during the course of prosecution, are set forth below:

15. A driver information device comprising:

a map display, special objects being represented on the map display by special object symbols, a common indicator symbol in the map display indicating a presence of corresponding multiple special objects one of (a) in one location and (b) within a preselected radius of a location, a selection of the common indicator symbol enabling a display of a selection menu containing information about the corresponding multiple special objects, wherein the selection menu is displayed on the map display;

wherein during the display of the selection menu, the common indicator symbol is displayable at a same location on the map where it was displayed before the display of the selection menu, embedded in the selection menu.

16. The driver information device according to claim 15, wherein during the display of the selection menu, the map display continues to be shown, with the selection menu superimposed on the map display.

17. The driver information device according to claim 15, wherein the selection menu includes a plurality of special object symbols corresponding to the multiple special objects indicated by the common indicator symbol, and wherein a desired special object within the selection menu is one of: a) selected as a desired destination; and b) selected for output of additional information regarding the desired special object.

18. The driver information device according to claim 17, wherein the selection of the desired special object is made using a selection frame within the selection menu.

EVIDENCE APPENDIX

In the present application, there has been no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132, or other evidence entered by the Examiner and relied upon by Appellants in the present appeal.

RELATED PROCEEDINGS APPENDIX

No appeal or interference which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal is known to exist.